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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,086	07/05/2001	Akira Morita	16869P-024200US	5868
20350	7590	07/16/2004		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER WORLOH, JALATEE	
			ART UNIT 3621	PAPER NUMBER

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/900,086	MORITA ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 May 2004.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10, 14, 17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 11, 15, 16, 18 and 19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10, 14, 17 and 20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/9/2004 &amp; 7/5/200</u>	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

1. Claims 1-10, 14, 17 and 20 have been examined.

### *Specification*

2. The disclosure is objected to because of the following informalities: typographical error, change “provided The” to “provided. The” (see page. 5, line 15).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5809144 to Sirbu et al.

Sirbu et al. disclose receiving billing information (i.e. “purchase order”) generated by said creditor system and authentication information generated by a debtor which is to make payment to said creditor, said authentication information varying according to ordering information and determining whether or not a payment request is valid based on said billing information and said authentication information (see col. 5, lines 60-67; col. 6 lines 1-24).

Referring to claim 7, Sirbu et al. disclose the authentication information is a hash value generated by using a hash function.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 8, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2002/0188574 to Niwa.

Referring to claims 1 and 3, Niwa discloses receiving login information, payment information, and authentication information (i.e. “authentication code”), said authentication information generated by a user using said payment information and first identity confirmation (i.e. “customer’s fingerprint”) and determining whether a request for a payment is valid using said second identity confirmation information (i.e. “stored fingerprint”) and said payment information and said authentication information; wherein said login information is a credit card number (see paragraphs [0033], lines 1-7 and [0035], lines 1-13). Niwa does not explicitly claim extracting second identity confirmation information associated with said login information from a database; however, this is an inherent step. Niwa teaches a database storing information relating to the accounts and the customers (see paragraph [0022]) including fingerprint identification (i.e. “second identity confirmation”) see paragraph [0033], lines 1-7. Therefore, before validating the request using the stored fingerprint (i.e. “second identity confirmation information”), it must first be extracted. At the time the invention was made, it would have been obvious to a person of ordinary skills in the art to develop a method that extracts second identity

confirmation form a database. One of ordinary skill in the art would have been motivated to do this because it effectively prevents fraud by ensuring the user's identity.

Referring to claim 8, Niwa discloses using a database to manage login information of users making payments through said financial institution in association with identity confirmation information for said users (see paragraph [0022]). Notice, Niwa's database stores "information concerning the accounts thereof and the customers utilizing them", which implies that the login information, identity information and other data relating the customer's transaction are stored. Niwa also disclose receiving from said merchant system login information identifying a user of said users making a payment request to a merchant, billing information for said payment request, and authentication information generated by said user using ordering information and said identity confirmation information, wherein said ordering information is a counterpart of said billing information and determining whether said payment request is valid or not using said identity confirmation information and said billing information and said authentication information (see paragraphs [0033], lines 1-7 and [0035], lines 1-13). Niwa does not explicitly claim extracting identity confirmation information associated with said login information from a database; however, this is an inherent step. Niwa teaches a database storing information relating to the accounts and the customers (see paragraph [0022]) including fingerprint identification (i.e. "identity confirmation") see paragraph [0033], lines 1-7. Therefore, before validating the request using the stored fingerprint, it must first be extracted. At the time the invention was made, it would have been obvious to a person of ordinary skills in the art to develop a method that extracts identity confirmation from a database. One of ordinary skill

in the art would have been motivated to do this because it effectively prevents fraud by ensuring the user's identity.

Referring to claim 9, Niwa discloses said payment request is rejected if billing information sent from said merchant system is different from ordering information extracted from said authentication information (see paragraph [0035], lines 7-13,21-25). Specifically, Niwa teaches analyzing the billing information and the ordering information for validity and rejecting non-valid request. Although, Niwa does explicitly disclose the comparing the billing information and ordering information, it is clearly implied.

Referring to claim 10, Niwa discloses the billing information, order information and authentication information (see claim 8 above). Niwa does not expressly disclose the billing information is billing amount and order information is payment amount, said authentication information is determined through calculations according to predetermined conditions using said payment amount information and said identity confirmation information. However, this difference is only found in the nonfunctional descriptive material and is not functionally in the steps recited. The receiving billing information, order information and authentication information and determining the payment request validity would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receiving billing information that is the billing amount, order information that is the order amount and authentication information that is calculated according to predetermined conditions

because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 14, Niwa discloses using a storage device (“i.e. database”) storing login information and first identity confirmation information for a user. Specifically, Niwa teach a database storing “information concerning the accounts thereof and the customers utilizing them”, which implies that the login information and first identity information are stored. Niwa also discloses a communication device (i.e. “payor bank’s processing unit”) receiving from said merchant system login information identifying a user of said users making a payment request to a merchant, billing information for said payment request, and authentication information generated by said user using ordering information and said identity confirmation information, and an control device (i.e. “payor bank’s processing unit”) determining whether said payment request is valid or not using said identity confirmation information and said billing information and said authentication information (see paragraphs [0022], [0033], lines 1-7 and [0035], lines 1-13). Niwa does not explicitly claim a control device extracting identity confirmation information associated with said login information from a storage device; however, this is an inherent step. Niwa teaches a database storing information relating to the accounts and the customers (see paragraph [0022]) including fingerprint identification (i.e. “identity confirmation”) see paragraph [0033], lines 1-7; therefore, before validating the request using the stored fingerprint, it must first be extracted. At the time the invention was made, it would have been obvious to a person of ordinary skills in the art to develop a method that extracts identity confirmation from a storage device. One of ordinary skill in the art would have been motivated to do this because it effectively prevents fraud by ensuring the user’s identity.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa as applied to claim 1 above, and further in view of US Publication No. 2002/0120584 to Hogan et al.

Niwa discloses authentication information (see claim 1 above). Niwa does not expressly disclose the authentication information is a hash value generated using a hash function. Hogan discloses the authentication information is a hash value generated using a hash function (see abstract, lines 5-7). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Niwa to generate a hash value of the authentication information using a hash function. One of ordinary skill in the art would have been motivated to do this because it transforms the authentication code into a message digest that can be used to detect if the code has been altered; thus, providing message integrity and preventing fraud.

8. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa in view of US Patent No. 5809144 to Sirbu et al.

Niwa discloses receiving login information, payment information, and authentication information (i.e. “authentication code”), said authentication information generated by a user using said payment information and first identity confirmation (i.e. “customer’s fingerprint”) (see paragraphs [0033], lines 1-7 and [0035], lines 1-7). Niwa does not explicitly claim extracting second identity confirmation information associated with said login information from a database; however, this is an inherent step. Niwa teaches a database storing information relating to the accounts and the customers (see paragraph [0022]) including fingerprint identification (i.e. “second identity confirmation”) see paragraph [0033], lines 1-7. Therefore,

before validating the request using the stored fingerprint (i.e. “second identity confirmation information”), it must first be extracted. Also, Niwa does not expressly teach determining payment information using said second identity confirmation information and said authentication information. Sirbu et al. disclose determining payment information (i.e. “price quotation”) using said second identity confirmation information and said authentication information (i.e. “authentication request”). At the time the invention was made, it would have been obvious to a person of ordinary skills in the art to modify the method disclose by Niwa to include the step of determining payment information using said second identity confirmation information and said authentication information. One of ordinary skill in the art would have been motivated to do this because it effectively prevents fraud.

Referring to claim 20, Niwa discloses using a database to manage a user ID of a user making a payment through said financial institution in association with first identity confirmation for said user (see paragraph [0022]). Specifically, Niwa teach a database storing “information concerning the accounts thereof and the customers utilizing them”, which implies that the login information and first identity information are stored. The information stored within the database is retrieved when transaction authorization is needed. Niwa also receiving from said merchant system user ID identifying a user making said payment to said merchant, billing information for said ion identifying a user of said users making a payment request to a merchant, billing information for said payment, and authentication information generated by said user using ordering information and second identity confirmation information, and determining whether said payment is valid using said identity confirmation information and said ordering information and said billing information and said authentication information (see paragraphs [0033], lines 1-7

and [0035], lines 1-13). Niwa does not expressly disclose a code for performing the above steps. However, Sirbu et al. disclose a code (i.e. "software") see col. 7, lines 48-63. At the time the invention was made, it would have been obvious to a person of ordinary skills in the art to develop a method disclose by Niwa to include a code for performing the steps. One of ordinary skill in the art would have been motivated to do this because it provides easy distribution of electronic content.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sirbu et al. as applied to claim 5 above in view of U.S. Patent No. 6324525 to Kramer et al.

Sirbu et al. disclose said authentication information is information from which a section of said ordering information is abbreviated (i.e. "first cryptographic checksum"), see col. 5, lines 51-67), said financial institution system (i.e. "account server") determines whether or not said payment request is valid (see col. 6, lines 20-23). Sirbu et al. do not expressly disclose the financial institution system abbreviating a section of billing information generated by said creditor system and making a comparison with said authentication information. Kramer et al. disclose the financial institution system abbreviating (i.e. creating a message digest) a section of billing information generated by said creditor system and making a comparison with said authentication information (see col. 20, lines 65-67 and col. 21, lines 1-10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sirbu et al. to include the step of the abbreviating a section of billing information generated by said creditor system and making a comparison with said authentication information. One of ordinary skill in the art would have been motivated to do this because it

transforms the authentication information and billing information into a message digest that can be used to detect if the data has been altered; thus, providing message integrity and preventing fraud.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6529885 to Johnson in view of Sirbu et al.

Johnson discloses a storage device (i.e. bank's storage), storing a list of financial institution through which payments are made, and a transaction with said buyer system, a communication device (i.e. bank) receiving from said buyer system information an identified financial institution system of said list of financial institutions, login information (i.e. "customer ID") identifying a buyer making a payment (see col. 6, lines 15-22 and 31-41), and authentication information (i.e. "password"), said authentication information generated by said buyer system, and sending to said identified financial institution system said login information, said authentication information (i.e. col. 10, lines 14-16). Johnson does not expressly disclose receiving billing information, and a control device generating said billing information based on said transaction. Sirbu et al. discloses receiving said billing information (i.e. "price") and a control device generating said billing information based on said transaction (see col. 5, lines 13-17 and 63-67). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Johnson to include the step of receiving said billing information and generating said billing information. One of ordinary skill in the art would have been motivated to do this because it ensures that all entities involved in the transaction are aware of the service price.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

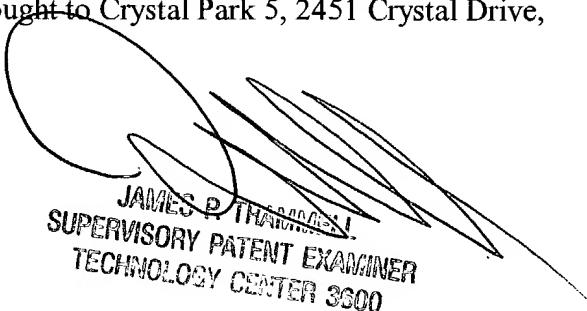
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July 2, 2004

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600